

REMARKS

Claims 8-19 are pending in this application.

By this Amendment, claim 19 is added. Reconsideration of the application is respectfully requested.

The Office Action applies new references JAIC 1984 ("JAIC"), U.S. Patent No. 4,646,914 to Gipson and University of Technology Sydney Adhesive Tape Database ("Database"), and rejects claims 8-18 under 35 U.S.C. §103(a) over Bonzo in view of these newly applied references. This rejection is respectfully traversed.

The Office Action asserts that JAIC and Gipson disclose that Scotch Branch tapes may have acrylic adhesive. The Office Action further asserts that Database discloses that Scotch Brand tapes may have acrylic adhesive with a thickness of 20 μm . Thus, the Office Action asserts that the Scotch Branch tapes used in Bonzo possess all features listed in Table 1 of the present application.

The Office Action acknowledges that the Examiner does not have the means to measure the adhesive force of the Scotch Brand tapes used in Bonzo in accordance with JIS Z0237. However, the Office Action asserts that the materials and thicknesses are similar to those of the adhesive film listed in Table 1. Therefore, the Office Action asserts that it is reasonable to conclude that the tapes used in Bonzo have an adhesive force similar to that of Example 2 listed in Table 1. Accordingly, the Office Action concludes that the tapes used in Bonzo have an adhesive force within the range recited in the claims.

However, Applicant respectfully submits that Bonzo does not disclose or suggest the features listed in Table 1 of the present application.

Bonzo discloses a film thickness of 0.025 millimeters. See col. 8, line 13. However, Bonzo does not disclose or suggest whether this "thickness" is the thickness of an adhesive layer or the total thickness of the film including the substrate layer. Thus, Bonzo does not

disclose or suggest the features listed in Table 1 of the present application, because Table 1 of the present application lists three examples, each with a total thickness significantly greater than 0.025 millimeters.

There is no logical connection between the disclosure of Bonzo with the features disclosed in JAIC, Gipson and Database, because Bonzo does not specify whether Bonzo's "thickness" is the thickness of the adhesive layer or the total thickness of the film, as discussed above, and thus does not specify a particular product disclosed in JAIC, Gipson and Database. Thus, Bonzo does not disclose the features listed in Table 1 of the present application, regardless whether JAIC, Gipson or Database may appear to disclose certain features listed in Table 1 of the present application.

Also, Bonzo does not inherently disclose whether Bonzo's "thickness" is the thickness of the adhesive layer or the total thickness of the film, because Bonzo's "thickness" could have several possibilities, and does not necessarily correspond to either the thickness of the adhesive layer or the total thickness of the film.

In particular, as stated in MPEP, inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See MPEP, §2112(IV). (Emphasis original).

In view of the above, Bonzo does not disclose or suggest the thickness characteristics listed in Table 1 of the present application. Thus, even if the acrylic adhesive material disclosed in Bonzo is "an acrylic polymer adhesive" as asserted in the Office Action, such an acrylic polymer adhesive is too general a term for one of ordinary skill to identify a specific material of the adhesive layer used by Bonzo. There are many kinds of acrylic adhesive

materials, and each of them has different adhesive force. Thus, a mere general term "acrylic polymer adhesive" does not provide the specifics of an adhesive force.

For example, a same acrylic adhesive material could produce different adhesive forces, if the adhesive tape is of different thickness. In particular, as shown in Table 1 of the present application, with a change of thickness of an adhesive layer, the adhesive strength changes from 8.58N/25mm (Example 1) to 12.26N/25mm (Example 2). Thus, even if Bonzo discloses "an acrylic polymer adhesive," Bonzo does not disclose or suggest the specific adhesive force, because Bonzo does not specify at least what Bonzo's "thickness" is.

In addition, JAIC suggests that "the composition and formulae of proprietary product may be altered by manufacturers", (page 103, line 24-25). Furthermore, JAIC suggests that "because of the possibility of formula changes in manufactured products, it is unwise to automatically apply testing data from a roll of tape manufactured in 1983, for example, to one manufactured in 1984", (page 103, line 30-32). Thus, it appears that the composition and prescription of a product frequently change. Therefore, the disclosure of JAIC and Database, even if combined with Bonzo, does not supply the subject matter lacking in Bonzo.

For at least the above reasons, withdrawal of the rejection of claims 8-18 under 35 U.S.C. §103(a) is respectfully requested.

Claim 19 is patentable at least in view of the patentability of claim 8, as well as for additional features it recites.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 8-19 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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